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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,158	11/13/2001	Earl J. Votolato	SPELL-004C	8649

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EXAMINER

DRUAN, THOMAS J

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 03/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/010,158

Applicant(s)

VOTOLATO, EARL J.

Examiner

Thomas J. Druan, Jr.

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is in response to Applicant's Preliminary Amendment received on 30 January 2002. The instant Office Action supercedes the Office Action mailed on 6 February 2002. The prior art cited in the Office Action of 6 February 2002 remains standing.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Amended claim 1, lines 3-4 state that the "first and second arms are biased." The term "biased" implies that some external force is acting on the arms, though it appears that in the resting or ready state, the arms, while resiliently connected, are not being urged either towards or away from each other. An example of a biased relationship as understood by the examiner is that of a pen with a shirt clip. The clip can be said to be biased against the pen since there is a reaction force acting on the clip by the pen. If the portion of the pen exerting the reaction force were to be removed, the clip would move into an unbiased resting state. Thus, either an explanation of the Applicant's usage of the term "biased" or alternative language describing the intended relationship between the first and second arms of the invention is required for clarity. In order to apply art, the term "biased" in claim 1 will not be considered.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 & 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Chen.

Chen discloses the invention as claimed including first and second arms with inner and outer surfaces, wherein said arms are in a tensioned movable opposed relationship to each other (fig. 1). Said first arm has a blade integral with the inner surface and opposing a groove in the inner surface of the second arm (fig. 3). The outer surfaces of the first and second arms are concavely contoured (fig. 2).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of Gilman.

Chen discloses the invention substantially as claimed, but lacks a description to tell if the invention is formed out of a single piece of material or if it includes a metal blade separate from a unitary body.

Regarding claims 4 and 5, Gilman discloses a slitting apparatus 10 with two arms 34/36 made of one piece of plastic (column 6, lines 35-38) and a blade 26 held within the inner surface of the upper arm 34 (column 5, lines 6-8). Forming the apparatus out of moldable plastic with the blade embedded therein is an inexpensive manufacturing method, and therefore it would have been obvious to make the invention of Chen with a blade embedded in a molded plastic body in order to reduce manufacturing costs. Furthermore, examiner takes Official Notice that it is old and well known in the art to use metal as a blade material due to its durability and hardness, and therefore it would have been obvious to make the blade of Gilman out of metal to have a durable, hard blade.

Regarding claims 2 and 3, the claimed embodiment is clearly anticipated because it involves no invention to form in one piece an article which has formerly been formed in two pieces and put together, as in claims 4 and 5 (see *Howard v. Detroit Stove Works*, 150 U.S. 164). Therefore, examiner takes Official Notice that it would have been obvious to make the slitting apparatus out of one piece since there is no inventive step beyond Chen in view of Gilman's two-piece slitting apparatus. Furthermore, examiner takes Official Notice that it would have been obvious to make the one-piece slitting apparatus out of a rigid plastic since it is well known to manufacture cutting tools out of plastics.

### ***Response to Arguments***

Applicant's arguments filed 30 January 2002 have been fully considered but they are not persuasive. Applicant contends that the cited references do not disclose or

suggest a bag slitting apparatus that includes first and second arms which are biased and in tensioned movable opposed relationship to each other such that a bag may be inserted between the first and second arms and slit. Furthermore, Applicant contends that the references do not disclose first and second concavely contoured outer surfaces.

Applicant's remarks are well taken; however, it is the examiner's position that the references anticipate and obviate the claimed invention. More specifically, Chen discloses a plastic bag opener having two resiliently connected opposing arms, one of which has a sharp triangular projection while the other has a blade tip receiver which is an open, laterally-walled concave groove for receiving the sharp projection and a portion of the bag, as is well known in the bag-slitting art. The width of the groove is transverse to the elongation of the arms. It is clear by the triangular shape of the blade, as best seen in Fig. 3, that, once the bag is punctured by said blade, the device can be slid along the edge of said bag in a continuous motion to slice the bag open. Figures 2 and 3 show concavely contoured outer surfaces by indicating concentric arcs in Figure 2 and shadow lines in Figure 3, indicating a rounded depression. Gilman is cited to teach a one-piece construction.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Druan, Jr. whose telephone number is 703-308-4200. The examiner can normally be reached on M-F (8:30-6:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 703-308-1082. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

*agp*  
tjd

March 7, 2002

*Boyer Ashley*  
**BOYER ASHLEY**  
**PRIMARY EXAMINER**